

REMARKS/ARGUMENTS

Status of the Application

In the Non-Final Office Action, claims 1-3, 6, 8, 10, and 13 were rejected. Applicants have amended claim 1 to clarify that the weight percentages of components A) and B) add up to 100 weight percent and that the weight percent of component C) is relative to the quantity of the entire coating composition (see page 2, lines 35-40, for support). Claim 10 was amended to clarify that it is now dependent on claim 1. Thus, claims 1-3, 6, 8, 10, and 13 are pending. No new matter was added.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 10 was rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 10 was rejected for depending from a canceled base claim. Applicants have amended claim 10 to depend from claim 1. Thus, Applicants submit that this rejection has been obviated.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-3, 6, 10, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maag et al. (DE-A-197 57 082, WO 99/26733, or U.S. Patent No. 6,531,188) in view of Richard (U.S. Patent No. 5,091,211). Applicants respectfully traverse these rejections.

Submitted herewith is a declaration under 37 C.F.R. § 1.132 signed by Helmut Löffler, a DuPont employee intimately familiar with the present application and its prosecution history, which establishes the unexpected results of Applicants' claimed invention. Mr. Löffler describes a series of experiments, also attached hereto, which demonstrate that the coating compositions of Maag *et al.* in combination with Richard fail to produce a repair coating having a cured filler layer with no edge marks when the top coat is applied.

Mr. Löffler explains that two coating compositions were prepared as described in Example 2 of Applicants' specification except that, instead of using isobornyl acrylate, comparative coating composition 1 used 2-hydroxy ethyl methacrylate and

comparative coating composition 2 used methyl methacrylate. Filler layers of the comparative coating compositions 1 and 2 were applied separately by spraying onto bright sheet steel to yield a dry layer thickness of 150 μm . Immediately after application, the filler layers were exposed to irradiation by a UV flash lamp (3500 W). Irradiation was performed by 30 flashes; a flash being triggered every four seconds.

Comparison of the two comparative coating compositions to the claimed invention could not be performed, however, because neither of the comparative coatings cured. Mr. Löffler concluded that “because a surfacer coating composition of Maag *et al.* in view of Richard produces a coating that does not cure and, consequently, cannot be used to produce a coating without edge marks as claimed in the present invention.”

Applicants claimed invention not only cures, but also produces the a filler coating that does not show edge marks when the top coat is applied. The “[p]resence of a property not possessed by the prior art is evidence of nonobviousness.” MPEP 716.02(a)(III) (citing *In re Papesch*, 315 F.2d 381 (CCPA 1963)). Applicants thus respectfully submit that the claimed invention has unexpected results over the references cited by the Examiner. The claimed invention should thus be patentable.

Mr. Löffler's declaration further evidences that there is no reasonable expectation of success in the Maag *et al.*/Richard combination. “Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.” MPEP § 2143.02 (citing *In re Rinehart*, 531 F.2d 1048 (CCPA 1976)). Here, the evidence submitted in the 132 declaration demonstrates that coatings disclosed by the Maag *et al.*/Richard combination not only fail to produce no edge marks, they also fail to cure at all under conditions set forth in the claimed invention. Without a reasonable expectation of success, the Examiner has failed to establish a *prima facie* case of obviousness.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Maag *et al.* in view of Richard in further view of Brehm *et al.* (U.S. Patent No. 5,700,576). Because claim 8 is a dependent claim, which recites even further limitations to claims that have already been traversed, Applicants rely upon the

arguments presented above in rebuttal to the Examiner's assertion that claim 8 is unpatentable.

Further, Applicants respectfully submit that there is no motivation or suggestion to combine Brehm et al. with Maag et al. and Richard. Brehm et al. is directed to scratch-resistant coatings for *plastic* articles. Indeed, the word "metal" is mentioned once in the entire disclosure of Brehm et al., and only to note that "[t]here is no expectation that thermoplastically deformable plastics will achieve the scratch-resistance of most metals or mineral glasses" (column 1, lines 16-18). On the other hand, the claimed invention is directed the application of a filler coating composition to a metal substrate (see step a of claim 1).

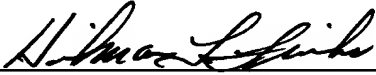
The Examiner cites *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327 (1945), for the proposition that "the selection of a known material based on its suitability for its intended use support[s] a prima facie obviousness determination." MPEP § 2144.07. In doing so, however, the Examiner oversimplifies the analysis in *Sinclair*. In *Sinclair*, a prior art reference disclosed the problem solved by the patentee. *Id.* at 333. All that was missing from the prior art reference was the compound that the patentee used to solve the problem. *Id.* This compound fit exactly within the characteristics defined by the prior art reference's description of what compound would solve the stated problem. *Id.* *Sinclair* thus warns that "[r]eading a list and selecting a known compound to meet *known* requirements is no more ingenious than selecting the last piece to put into the last opening in a jig-saw puzzle." *Sinclair*, 325 U.S. at 335 (emphasis added).

Here, however, the primary reference used by the Examiner, Maag et al., does not teach the problem solved by the Applicants, namely, a process for coating metal substrates with filler coating compositions curable by irradiation with high energy radiation. Without having a reference that sets forth the requirements of the problem solved by Applicants, the Examiner's use of *Sinclair* to establish a *prima facie* case of obviousness must fail.

Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

By: 
Hilmar Fricke
Attorney for Applicants
Reg. No.: 22,384
Telephone: (302) 984-6058
Facsimile: (302) 658-1192

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